

IN THE

**Supreme Court of the United States**

OCTOBER TERM, 1975

No. **75-1743**

FRANK PETER DOYLE, JOHN HERBERT CHARLES NAYLER  
and GEORGE NEWBOLD ROLINSON,

*Petitioners,*

—v.—

JOHN C. SHEEHAN,

*Respondent.*

**PETITION FOR A WRIT OF CERTIORARI TO THE  
UNITED STATES COURT OF APPEALS  
FOR THE FIRST CIRCUIT**

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Frank Peter Doyle, John Herbert Charles Nayler and George Newbold Rolinson, the above Petitioners, request that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the First Circuit entered in this case on January 30, 1976.

**Opinions Below**

The Opinion of the Court of Appeals for the First Circuit is reported at 529 F.2d 38 and 188 USPQ 545. A copy is attached hereto as Appendix A. The opinion of the United States District Court for Massachusetts is not reported; a copy is attached hereto as Appendix B.



### Jurisdiction

The judgment of the Court of Appeals for the First Circuit was entered on January 30, 1976. A timely Petition for Rehearing *en banc* was denied on March 3, 1976, and this Petition for a Writ of Certiorari was filed within ninety days of that date. This court's jurisdiction is invoked under 28 U.S.C. §1254(1).

### Questions Presented

For over ten years the federal courts have overseen "discovery" for use in Patent Office interferences\* pursuant to 35 U.S.C. §24. During the period from 1966 to 1974, the Second, Third, Fifth, Sixth, Seventh and Tenth Circuits uniformly recognized the right of parties to a Patent Office interference to obtain discovery of documents and materials and to take depositions for use in such proceedings. In 1975, the Third Circuit, in *Frilette, et al. v. Kimberlin, et al.* and a companion case of *Duffy v. Barnes, et al.*, 508 F.2d 205 (C.A. 3, 1974), cert. denied, 421 U.S. 979 and 980 (1975), overruled its eight prior opinions and the twelve decisions of the district courts within the Third Circuit and interpreted 35 U.S.C. §24 in a manner which precluded Patent Office interference parties from obtaining Federal Court discovery under §24. The First Circuit, in

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\* An interference is a proceeding in the Patent and Trademark Office between two or more parties, each of whom claims to be the first inventor of the same subject matter. The purpose of the proceeding is to establish which party is, in fact, the first inventor, since only the true first inventor is entitled to receive a patent and the accompanying seventeen-year monopoly under the Patent Statutes.

its decision sought to be reviewed by this Petition, adopted much of the reasoning of the Third Circuit. In the meantime, the Second Circuit reaffirmed the right of patent interference parties to obtain discovery under 35 U.S.C. §24. See *Shattuck, et al. v. Hoegl, et al.*, 523 F.2d 509 (C.A. 2, 1975).

The First Circuit adopted much of the Third Circuit's interpretation of 35 U.S.C. §24, in its decision below, and has thus rendered a decision contrary to that of five other Circuit Courts of Appeals. The First Circuit recognized the split its decision was causing:

We regret the uncertainty which a circuit split creates. There are, however, possible remedies. The Supreme Court may think it desirable to terminate the divergent interpretations that now exist.

The questions presented are as follows:

1. Should the phrase in 35 U.S.C. §24, "The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office," be interpreted to mean that only Federal Rule of Civil Procedure 45, *and only* subparts (a), (b), (c), (d)(2), (e) and (f) [*but not (d)(1)*], shall apply as the First Circuit has stated?

2. Should the phrase in 35 U.S.C. §24, "The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office," be interpreted contrary to the "plain meaning" of the words used to restrict the applicable Federal Rules to

less than all the rules relating to the attendance of witnesses and to the production of documents and things?

3. Should the Federal Courts deny discovery of documents and things in Patent Office interferences thereby suppressing the discovery of relevant and material documents and things so that the Patent Office will in turn render a decision in an interference based on less than all of the relevant evidence?

#### Statutes Involved

35 U.S.C. §24 reads as follows:

##### §24. Subpoenas, witnesses

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent and Trademark Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office.

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish dis-

obedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena.

As amended Jan. 2, 1975, Pub.L. 93-596, § 1, 88 Stat. 1949.

35 U.S.C. §54, prior to July 19, 1952, read as follows:

The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpoena for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits at any time and place in the subpoena stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him; and the provisions of section 647, of Title 28 relating to the issuance of subpoenas duces tecum shall apply to contested cases in the Patent Office.



### Statement of the Case

Frank Peter Doyle, John Herbert Charles Nayler and George Newbold Rolinson, the Petitioners herein and John C. Sheehan, the Respondent herein, are involved in an interference in the Patent and Trademark Office, the purpose of which is to determine which of the parties was the first inventor of a basic and commercially valuable process for producing a very wide range of penicillins, including most of those currently being sold. These penicillins are antibiotics and are administered each year to millions of people by doctors throughout the United States and the rest of the world to treat bacterial infections.

From 1964 through 1970, Doyle *et al.* sought unsuccessfully to compel the Patent Office to declare an interference between their patent application and Sheehan's then-pending patent application, which, on December 1, 1964, was issued as U. S. Patent No. 3,159,617. Doyle *et al.*'s activities in pursuance of a declaration of interference began with a request in the Patent Office and included litigation in the District Court for the District of Columbia, the Court of Appeals for the District of Columbia and a Petition for Certiorari to this court. Finally, on February 18, 1971, the Patent and Trademark Office declared the requested interference. The Patent Office has suspended the interference proceeding pending resolution of Doyle *et al.*'s request for additional discovery.

Doyle *et al.* are British subjects residing in Great Britain, while Sheehan is a United States citizen residing in Massachusetts. Pursuant to 35 U.S.C. §24, Doyle *et al.* applied to the District for Massachusetts for a subpoena duces tecum for service on John C. Sheehan and pursuant

thereto have already taken a discovery deposition and had production of documents. In that earlier proceeding, the District Court for Massachusetts denied Sheehan's motion to quash the subpoena duces tecum.

As a result of the documents and materials produced and the deposition of John C. Sheehan, Doyle *et al.* discovered an apparent discrepancy between the laboratory notebooks produced by Sheehan involving the invention which he claimed was his, which notebooks showed that all the work on the invention was performed by someone else, and the inventorship entity on the Sheehan patent, which was Sheehan alone. Since Sheehan, in the Patent Office interference, was relying on a date of an earlier abandoned application filed in his name alone to establish that he was the first inventor and should be awarded the right to the patent for the invention in question, Doyle *et al.* sought further production of documents pursuant to 35 U.S.C. §24 and again obtained a subpoena duces tecum from the Massachusetts District Court for the purpose of taking further discovery on the question of this apparent inventorship discrepancy. Doyle *et al.* believe that the documents and materials requested in the subpoena duces tecum served on Sheehan will reveal a concerted plan by Sheehan pursuant to which he named himself as the sole inventor of numerous inventions despite the fact that the inventions were actually produced by various graduate and postgraduate students within his Department of Chemistry at the Massachusetts Institute of Technology. Upon being served with this second subpoena duces tecum, Sheehan again moved in the District Court to quash the subpoena, which action Doyle *et al.* opposed. After resetting the case for hearing four different times, the District Court "allowed" Sheehan's Motion to

Quash without a hearing while the case was on the hearing calendar.

Doyle *et al.* thereafter appealed to the First Circuit Court of Appeals, which court affirmed the quashing of the subpoena duces tecum served on Sheehan.

## REASONS FOR GRANTING THE WRIT

### 1. The Decision of the First Circuit Directly Conflicts With Decisions of the Second, Fifth, Sixth, Seventh and Tenth Circuits and Numerous District Courts Which Have Uniformly Recognized That Parties to a Patent Office Interference May Obtain Discovery in a Federal Court Proceeding Pursuant to 35 U.S.C. §24.

The First Circuit recognized that its decision was creating a split within the circuits:

We regret the uncertainty which a circuit split creates. There are, however, possible remedies. The Supreme Court may think it desirable to terminate the divergent interpretations that now exist.

In the briefs before it, and at oral argument, Doyle *et al.* discussed in detail the ten years of case law recognizing the right of a party to a Patent Office interference to obtain discovery from his adversary in an ancillary proceeding under 35 U.S.C. §24.\* (See Appendix D for a summary of

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\* *In re Natta*, 388 F.2d 215 (CA 3, 1968); *Natta et al. v. E. I. du Pont de Nemours & Co.*, 410 F.2d 187 (CA 3, 1969); cert. den'd 163 USPQ 704; *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, 415 F.2d 875 (CA 3, 1969); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, 432 F.2d 385 (CA 3,

cases.) Moreover, until 1975, the Third Circuit, in eight separate opinions, had acknowledged the right of interference parties to discovery pursuant to the Federal Rules of Civil Procedure and 35 U.S.C. §24.\* During the nine-year period from 1966 to the time of *Frilette et al. v. Kimberlin et al.* and the companion case of *Duffy v. Barnes et al.*, *supra*, there were twelve decisions of District Courts within the Third Circuit recognizing an interference party's right

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1970); cert. den'd 168 USPQ 673; *Montecatini Edison S.p.A. v. E. I. du Pont de Nemours & Co.*, 434 F.2d 70 (CA 3, 1970); *Vogel et al. v. Jones et al.*, 443 F.2d 257 (CA 3, 1971); cert. den'd 404 US 987 (1971); *Vogel et al. v. Jones et al.*, 350 F. Supp. 419 (DC NJ, 1972); aff'd 464 F.2d 574 (CA 3, 1972); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, 457 F.2d 1307 (CA 3, 1972).

*In re Natta et al.*, only at 151 USPQ 93 (DC Del., 1966); *In re Natta*, 264 F. Supp. 731 (DC Del., 1967); *International Business Machines Corporation v. Sperry Rand Corporation*, only at 155 USPQ 633 (DC Del., 1967); *Hellwarth et al. v. Gould et al.*, 46 FDR 620 (DC Del., 1967); *Taub et al. v. Rausser et al.*, only at 159 USPQ 220 (DC NJ, 1968); *In re Natta et al.*, only at 162 USPQ 338 (DC Del., 1969); *In re Natta*, 48 FRD 319 (DC Del., 1969); *In re Natta*, only at 164 USPQ 71 (DC Del., 1969); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, only at 166 USPQ 390 (DC NJ, 1970); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, 54 FRD 474 (DC NJ, 1971); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, only at 173 USPQ 480 (DC NJ, 1972); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, only at 174 USPQ 147 (DC NJ, 1972).

\* *In re Natta*, 388 F.2d 215 (CA 3, 1968); *Natta et al. v. E. I. du Pont de Nemours & Co.*, 410 F.2d 187 (CA 3, 1969); cert. den'd 163 USPQ 704; *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, 415 F.2d 875 (CA 3, 1969); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, 432 F.2d 385 (CA 3, 1970); cert. den'd 168 USPQ 673; *Montecatini Edison S.p.A. v. E. I. du Pont de Nemours & Co.*, 434 F.2d 70 (CA 3, 1970); *Vogel et al. v. Jones et al.*, 443 F.2d 257 (CA 3, 1971); cert. den'd 404 US 987 (1971); *Vogel et al. v. Jones et al.*, 350 F. Supp. 419 (DC NJ, 1972); aff'd 464 F.2d 574 (CA 3, 1972); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, 457 F.2d 1307 (CA 3, 1972).



to discovery under the Federal Rules of Civil Procedure pursuant to 35 U.S.C. §24.\*

While the First Circuit's decision adopted the reasoning of the Third Circuit in *Frilette v. Kimberlin*, *supra*, subsequent to that decision of the Third Circuit, the Second Circuit reaffirmed the right of discovery in *Shattuck et al. v. Hoegl et al.*, *supra*. Therefore, the First Circuit decision stands in direct contradiction to the position of the Courts of Appeals for the Second, Fifth, Sixth, Seventh and Tenth Circuits.

**2. The First Circuit's Interpretation of 35 U.S.C. §24 Which Restricts the Phrase "Federal Rules of Civil Procedure" to Mean Federal Rule of Civil Procedure 45 Except for Subpart (d)(1) Is in Direct Conflict With This Court's "Plain Meaning" Rule of Statutory Interpretation.**

35 U.S.C. §24 says:

The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.

\* *In re Natta et al.*, only at 151 USPQ 93 (DC Del., 1966); *In re Natta*, 264 F. Supp. 734 (DC Del., 1967); *International Business Machines Corporation v. Sperry Rand Corporation*, only at 155 USPQ 633 (DC Del., 1967); *Hellwarth et al. v. Gould et al.*, 46 FRD 620 (DC Del., 1967); *Taub et al. v. Rausser et al.*, only at 159 USPQ 220 (DC NJ, 1968); *In re Natta et al.*, only at 162 USPQ 338 (DC Del., 1969); *In re Natta*, 48 FRD 319 (DC Del., 1969); *In re Natta*, only at 164 USPQ 71 (DC Del., 1969); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, only at 166 USPQ 390 (DC NJ, 1970); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, 54 FRD 474 (DC NJ, 1971); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, only at 173 USPQ 480 (DC NJ, 1972); *The Babcock & Wilcox Company v. Foster Wheeler Corporation*, only at 174 USPQ 147 (DC NJ, 1972).

Doyle *et al.* and Sheehan are involved in an interference—a "contested case(s) in the Patent Office." Doyle *et al.* have sought "production of documents" from Sheehan by serving him with a subpoena duces tecum issued by the District Court below.

The "plain meaning" of §24 is that the discovery rules of the Federal Rules of Civil Procedure apply to Patent Office interferences. This court has said many times that statutes are to be interpreted according to the plain meaning of the words used therein.

In *Banks v. Chicago Grain Trimmers Assn., Inc., et al.*, 390 U.S. 459 (1968), this court was called upon to interpret a portion of the Longshoremen's and Harbor Workers' Compensation Act which provided for review "because of a mistake in a determination of fact," by the Deputy Commission, "at any time prior to one year after the rejection of a claim." The court stated:

We find nothing in this legislative history to support the respondent's argument that a 'determination of fact' means only some determinations of fact and not others. The respondent points out that the recommendations of the Compensation Commission prior to the 1934 amendment referred to analogous state laws; but those recommendations dealt with the time period in which review was to be available, not with the grounds for review. The respondent has referred us to no decision, state or federal, holding that a statute permitting review of determinations of fact is limited to issues relating to disability. In the absence of persuasive reasons to the contrary, we attribute to the words of a statute their ordinary meaning, and we hold that the petitioner's second compensation action, filed a few

months after the rejection of her original claim, came within the scope of §22.

In *Malat v. Riddell*, 383 U.S. 596 (1966), this court was called upon to construe the word "primarily" in connection with a development of a property for rental purposes or sale, which would then determine whether the profits received capital gains treatment or were treated as ordinary income. In that case, the court stated:

As we have often said 'the words of statutes—including revenue acts—should be interpreted where possible in their ordinary, everyday senses.' *Crane v. Commissioner*, 331 U.S. 1, 6. And see *Hanover Bank v. Commissioner*, 369 U.S. 672, 687-688; *Commissioner v. Korell*, 339 U.S. 619, 627-628. Departure from a literal reading of statutory language may, on occasion, be indicated by relevant internal evidence of the statute itself and necessary in order to effect the legislative purpose. See, e.g., *Board of Governors v. Agnew*, 329 U.S. 441, 446-448.

It is believed clear from those decisions that there is absolutely no basis for the First Circuit to interpret 35 U.S.C. §24 to say that the phrase, "The Federal Rules of Civil Procedure" means only Rule 45 of the Federal Rules of Civil Procedure—but not all of Rule 45—*subpart (d)(1) being specifically excluded by the court's opinion*. Of course, the court's need to exclude that subpart is clear: Subpart (d)(1) of Rule 45 of the Federal Rules of Civil Procedure refers to Rules 26, 30 and 31, which would have the effect of making those Federal Rules of Civil Procedure relating to discovery effective, which is the clear intent of the statutory language employed by Congress but in direct conflict with the First Circuit's opinion.

In *Helvering v. Hammell*, 311 U.S. 540 (1941), this court spoke to the question of restrictive interpretation of statutory language:

True, courts in the interpretation of a statute have some scope for adopting a restricted rather than a literal or usual meaning of its words where acceptance of that meaning would lead to absurd results, *United States v. Katz*, 271 US 354, 362, 70 L ed 986, 990, 46 S Ct 513, or would thwart the obvious purpose of the statute, *Haggar Co. v. Helvering*, 308 US 389, 84 L ed 340, 60 S Ct 337. *But courts are not free to reject that meaning where no such consequences follow and where, as here, it appears to be consonant with the purposes of the Act as declared by Congress and plainly disclosed by its structure.* [Emphasis added.]

When the *Helvering* case is viewed in the light of this court's later statement in *Segal, et al. v. Rochell*, 382 U.S. 375 (1966), wherein it stated:

Nevertheless, we have been shown no legislative history on the point, and an uncertain guess as Congress' intent provides dubious ground for disregarding its plain language.

it is believed unequivocally clear that the First Circuit has adopted an interpretation of 35 U.S.C. §24 which is not only violative of the plain meaning rule of statutory interpretation, but clearly contrary to the intent of Congress.

35 U.S.C. §24 is a compilation of former §§54, 55 and 56 with the change that, instead of specific reference to §647 of Title 28 relating to the issuance of subpoenas



duces tecum, 35 U.S.C. §24 refers to the "provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and the production of documents and things." (See and contrast the language of 35 U.S.C. §54 and 35 U.S.C. §24, *supra*.) Had Congress intended to restrict the applicable Federal Rules of Civil Procedure to the subpoena power of Rule 45, then, as Judge Van Dusen pointed out in his dissent in *Frilette v. Kimberlin*, *supra*, Congress would have retained the wording of 35 U.S.C. §54 and merely substituted "Federal Rule of Civil Procedure 45" for "section 647 of Title 28." (See Appendix C for Judge Van Dusen's dissent.) There is no legislative history on 35 U.S.C. §24 and therefore one cannot, from reading the Congressional records, refer to specific statements of Congress. However, even a casual reference to 35 U.S.C. §24 will demonstrate a complete lack of justification for saying that the phrase, "Federal Rules of Civil Procedure," means, in fact, *Federal Rule* [singular] "45(a), (b), (c), (d)(2), (e) and (f)", but *not* (d)(1).

**3. The Effect of the First Circuit's Decision Will Be to Suppress Relevant and Material Evidence so That When an Interference Reaches the Patent and Trade Mark Office's Board of Patent Interferences for Decision, the Case Will Be Decided on a Record Which Contains Less Than All of the Relevant and Material Evidence.**

If the First Circuit's interpretation of 35 U.S.C. §24 is permitted to stand, discovery for use in Patent Office interferences will be precluded in that Circuit. Relevant and material evidence will be suppressed. Documents and materials properly "discoverable" which lead to relevant and material admissible evidence will never come to light in the first instance. The Patent Office will decide cases on incomplete evidence. One party who lacks full candor

may improperly obtain a seventeen-year patent monopoly through fraud or the simple suppression of relevant evidence on obviousness, test results or the intentional misnaming or omission of inventors.

Surely, in a matter as important as granting a patent to the proper party, all relevant and material evidence should be brought out through the discovery process so that the Patent Office will have a full and complete evidentiary record before it when it renders a decision.

## CONCLUSION

Doyle *et al.*, request that a Writ of Certiorari issue to review the judgment and opinion of the First Circuit. There is a clear conflict in the Courts of Appeals between the First and Third Circuits, on the one hand, and the Second, Fifth, Sixth, Seventh and Tenth Circuits together with numerous district courts, on the other hand. The First Circuit recognized that its decision was creating a split within the circuits and suggested:

The Supreme Court may think it desirable to terminate the divergent interpretations that now exist.

In its most recent decision, the Second Circuit has maintained its previous position along with the Fifth, Sixth, Seventh and Tenth Circuits in recognizing the right of patent interference parties to discovery under 35 U.S.C. §24.

It is therefore clear that absent issuance of a Writ of Certiorari, parties involved in Patent Office interferences will be forced to forum shop. Those seeking discovery will attempt to secure such discovery from the

opposing party in favorable districts, such as the Second, Fifth, Sixth, Seventh and Tenth Circuits, or the various District Courts in Circuits other than the First and Third which have recognized the right of parties to take discovery. In turn, parties from whom discovery is sought will no doubt try to argue that they are only properly within the jurisdiction of the First and Third Circuits and that discovery is thus precluded.

35 U.S.C. §24 involves a fundamental right to discovery under the Federal Rules of Civil Procedure. Failure to permit discovery can result in awarding the right to a patent and the accompanying seventeen-year monopoly to the wrong party which would be clearly contrary to the intent of the United States patent statutes (Title 35 of the United States Code) and the Constitution of the United States, Article I, Section 8.

Respectfully submitted,

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## APPENDICES



APPENDIX A

**United States Court of Appeals  
For the First Circuit**

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No. 75-1218

JOHN C. SHEEHAN,  
PLAINTIFF, APPELLEE,  
*v.*  
DOYLE, ET AL.,  
DEFENDANTS, APPELLANTS.

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APPEAL FROM THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF MASSACHUSETTS  
[HON. WALTER J. SKINNER, *U.S. District Judge*]

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Before COFFIN, *Chief Judge*,  
McENTEE and CAMPBELL, *Circuit Judges*.

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*Thomas E. Spath, with whom N. Dale Sayre, McLean, Boustead & Sayre, Robert J. Horn, Jr., and Kenway and Jenney were on brief, for appellee.*

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January 30, 1976

*Pre Curiam.* In this appeal, Doyle questions the wisdom of our decision in *Sheehan v. Doyle*, 513 F.2d 895 (1st Cir. 1975). In that case, Sheehan had sought documentary discovery from Doyle, and the latter had defended on grounds that Doyle, a nonresident alien, was beyond the jurisdiction and venue of the district court. We sustained Doyle, but on the ground that 35 U.S.C. § 24 "does not confer jurisdiction upon the district court, acting on its own, to grant Rule 34 discovery directly, whether against a nonresident alien or a resident citizen." 513 F.2d at 898. In this, we relied heav-

ily on the *en banc* decision of the third circuit in *Frilette v. Kimberlin*, 508 F.2d 205 (1975). In the present proceeding, it is Doyle who seeks discovery; and, after being peremptorily turned down by the district court on the basis of our decision in *Sheehan v. Doyle*, he bring this appeal.

We first dispose of Doyle's argument that as the discovery he seeks is by a *subpoena duces tecum*, it is not precluded by our earlier decision. The thrust of that decision was that 35 U.S.C. § 24 provided for judicial subpoenas to be used in aid of contested Patent Office cases (including for purposes of broad-based Federal Rules discovery) but only to the extent permitted by the Commissioner of Patents. What we rejected, and this would apply as much in the present case as in the earlier one, was use of the federal district courts "as alternative forums of first resort rather than as forums acting strictly in aid of the primary proceeding." 513 F.2d at 899. Thus the district court correctly interpreted our decision as ruling out administratively unauthorized\* discovery of this nature.

Here, if discovery proceeds, it will be more of the free-wheeling discovery which the third circuit and this circuit have determined Congress did not mean to authorize. Indeed, the very nature of the discovery here sought points up our earlier objections. Doyle seeks to probe whether Sheehan was the actual inventor, and Sheehan argues that that issue is entirely irrelevant to a patent office interference. Since the discovery proceeding is totally separate from the interference, and since no one from the Patent Office is a party or has purported to outline the scope of

\* From the Patent Office's granting of several continuances to permit court-sponsored discovery, Doyle argues tacit Patent Office approval of these proceedings. However, until 1975, all circuits considering the issue had ruled that independent discovery of this nature was in order, and the Patent Office had every reason to feel that it was obliged to go along willy nilly. Thus we draw no inferences from any Patent Office continuances.

discovery, the district judge would have to rule on this and similar contentions with little to guide him but the parties' conflicting ideas of what might or might not be deemed relevant by the Board of Patent Interferences. Plainly the issue of what is relevant to its own proceeding can best be determined, at least initially, by the administrative agency in question. For over 400 district judges scattered throughout the nation to attempt to rule on such questions in a vacuum scarcely seems sensible, and, as pointed out in *Frilette*, is a procedure without precedent elsewhere.

This brings us to whether or not we should abandon the construction of 35 U.S.C. § 24 that we adopted in *Sheehan v. Doyle*. We see no reason now to change our mind.\* Plainly, as we were well aware last spring, § 24 admits of more than one reading. But for reasons stated both in *Frilette* and our own opinion, we can see little sense in the sort of proceeding that a contrary interpretation has generated. Were the legislative history and statute clear, we would have no recourse; but the legislative history is totally devoid of any indication that Congress had in mind such an anomalous and unusual result, and we are unwilling to settle for what we perceive to be a fundamentally unsound approach where an equally or more persuasive interpretation of the statute exists.

We regret the uncertainty which a circuit split creates. There are, however, possible remedies. The Supreme Court may think it desirable to terminate the divergent interpretations that now exist. Alternatively, other circuits may follow the third circuit in abandoning the earlier construction. And the Commissioner of Patents, exercising such powers as he now has, may find that he is able to contribute

\* See note, *Discovery in Patent Interference Proceedings*, 89 Harv. L. Rev. 573 (1976), supporting our reading of the statute and view of the statutory history.

to clarification of the situation. Finally, of course, Congress may by legislative enactment make clear its wishes in this unsettled area.

*Affirmed.*

# APPENDIX B

Decision by Mr. Justice Walter Jay Skinner

The Court of Appeals having ruled on March 31, 1975, the motion to quash the subpoena is allowed, without leave, in accordance with the opinion of the Court of Appeals.

5-31-75

W. J. Skinner, U.S. J.



## APPENDIX C

No. 11, 287 F.2d 810, 818 (3d Cir. 1961); *Hennessey v. Securities & Exchange Commission*, 285 F.2d 511, 515 (3d Cir. 1961). "The provisions of the Federal Rules of Civil Procedure" does not plainly mean only one of these Rules, namely, Rule 45, as decided by the majority. In addition to the plain meaning of the present statutory language, an analysis of the previous language and amendments thereto contradicts the majority's position. The applicable statutory language, as contained in Title 35 U.S.C. prior to the July 1952 Act, and the substitute language in 35 U.S.C. § 24 are set out as follows:

VAN DUSEN, Circuit Judge, dissenting.

I respectfully dissent from the holding of the majority that 35 U.S.C. § 24, as worded in 1952, limits the ancillary jurisdiction of the district courts "to the issuance of subpoenas as permitted by prior practice." This holding is specifically stated by the majority above:

"We hold that 35 U.S.C. § 24 in referring to 'provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents' refers to the matters encompassed by Fed. R. Civ. P. 45(a), (b), (c), (d)(2), (e), and (f)."

The majority opinion concedes at page 270 that we are "bound by" any jurisdiction conferred on the federal district courts by Congress.<sup>1</sup> The majority nevertheless appears to believe that district court jurisdiction, as mandated by the plain meaning of 35 U.S.C. § 24, is undesirable. Thus the majority disregards the following language, first included in § 24 by the Act of July 19, 1952, c. 950, § 1, 66 Stat. 795:

"The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office."

The plain or ordinary meaning of words used in a statute is applied in its construction. See *Banks v. Chicago Grain Trimmers Ass'n*, 390 U.S. 459, 465 (1968); *Malat v. Riddle*, 383 U.S. 569, 571 (1966); *Hughes v. Local* not the reason for rejection of that case. If Natta had correctly interpreted § 24, the side effects would be worthy of note, but not grounds for disavowal of jurisdiction.

§ 1321 and S. 2504 would give authority to the Patent Office to issue subpoenas and require the Commissioner of Patents to establish rules for discovery similar to those of the Federal Rules of Civil Procedure. S. 2930 requires issuances of subpoenas by the clerk of the District Court and provides that the Federal Rules of Civil Procedure as applicable to discovery shall apply.

<sup>1</sup> I do not disagree with the majority opinion's statement that the language of the majority in *In re Natta*, 388 F.2d 215, 156 USPQ 289 (3d Cir. 1968), gave an unjustifiably broad interpretation to the 1952 amendment to 35 U.S.C. § 24.

35 U.S.C. § 54 prior to July 19, 1952

"The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpoena for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits at any time and place in the subpoena stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him; and the provisions of section 647, of Title 28<sup>2</sup> relating to the issuance of subpoenas duces tecum shall apply to contested cases in the Patent Office." (Emphasis supplied.)

<sup>2</sup> The words "F.R. Civ. P. 45" had been substituted for "section 647 of Title 28" by the terms of 28 U.S.C. § 723b and c (Act of June 19, 1934, Ch. 651, 48 Stat. 1064, which was amended by Act of June 25, 1948, Ch. 646, 62 Stat. 961), which terms are now contained in 28 U.S.C. § 2072 as follows:

First paragraph of 35 U.S.C. § 24 after July 19, 1952

"The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office." (Emphasis supplied.)

The reference to Rule 45 was effectively contained in the statute prior to the 1952 Act. Not only did the amending language alter this reference, but it also referred for the first time to the "provisions of the . . . Rules . . . relating to . . . the production of documents and things." These exact words were used in the title of Rule 34 as it existed in 1952. The title to this Rule, as amended in 1946,<sup>3</sup> read as follows in 1952:

"Rule 34. Discovery and Production of Documents and Things for Inspection, Copying, or Photographing."

As opposed to this title, the titles and subtitles of Rule 45 read as follows:

"Rule 45.

"SUBPOENA

"(a) For Attendance of Witnesses; Form; Issuance.

...

"(b) For Production of Documentary Evidence.

...

"(c) Service.

...

"(d) Subpoena for Taking Depositions; Place of Examination.

...

"(e) Subpoena for a Hearing or Trial.

...

"(f) Contempt.

...

According to the plain meaning of the words used in (a) 35 U.S.C. § 24, as amended in 1952, and (b) Rules 34 and 45, it seems clear that the words "The Federal Rules of Civil Procedure" referred at least to Rule 34 as well as Rule 45. Otherwise, Congress could have retained the wording of 35 U.S.C. § 54, merely substituting "Federal Rule of Civil Procedure 45" for "section 647 of Title 28."<sup>4</sup>

"All laws in conflict with such rules shall be of no further force or effect after such rules shall have taken effect." Title 28, section 647, was repealed when F.R. Civ. P. 45 became effective in April 1938. See U.S.C.A. Tables, I, Revised Titles, at 43.

<sup>3</sup> See page 13 of House Document 473, 80th Cong., 1st Sess.

<sup>4</sup> See note 2 above. Congress might have hesitated to cite in § 24 a single rule of procedure, since the rules are not statutes and thus not subject to the closest congressional control over content and wording. Nevertheless, no reason appears why Congress would have failed to specify the provisions of the Rules of Civil Procedure relating to subpoenas had the intent been to limit the reference to Rule 45. Also, the legislative history of the 1952 Act shows that Congress changed the language of 35 U.S.C. § 24 as it first appeared in a draft bill to provide that "the provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply

## A. Frilette Case

In the Frilette case, during the preparations-for-testimony stage, prior to the commencement of the junior party Frilette's taking of testimony, Frilette filed a motion for discovery with the Board of Patent Interferences under Patent Office Rule 287(c), seeking certain information from Kimberlin. The Board of Patent Interferences denied the motion in a decision dated January 17, 1973, on the ground, inter alia, that the motion under 287(c) for additional discovery was premature "since the time for service of documents and lists by Kimberlin . . . , the senior party, under Rule 287(a) has not closed and in view of the fact that it is therefore not known what documents and lists will be served . . . ."

Frilette also filed in the district court a motion to compel discovery under F.R. Civ. P. 37. In this motion, Frilette sought substantially the same discovery sought in the Patent Office, and requested an order compelling Kimberlin (1) to designate certain witnesses under F.R. Civ. P. 30(b)(6), (2) to answer certain interrogatories under F.R. Civ. P. 33, (3) to produce documents under F.R. Civ. P. 34, and (4) to admit certain facts under F.R. Civ. P. 36. A hearing on this motion was held before the district court, and, in an Opinion and Order dated May 15, 1973, the district court denied the motion. See *Frilette v. Kimberlin*, 358 F.Supp. 493, 178 USPQ 387 (D. Del. 1973).

Frilette appeals from this denial of his motion.

to contested cases in the Patent Office. H.R. 9133 was introduced in the 81st Congress on July 17, 1950, and this bill was reintroduced in revised form in the 82nd Congress as H.R. 3760, which became the Patent Act of July 19, 1952 (P.L. 593, 82nd Cong., 2d Sess., c. 950; 66 Stat. 792). H.R. 9133 contained this language in the last half of the last sentence of the first paragraph of 35 U.S.C. § 24:

"... and the provisions of the Federal Rules of Civil Procedure relating to the issuance of subpoenas duces tecum shall apply to contested cases in the Patent Office."

When this bill was reintroduced in revised form in the 82nd Congress as H.R. 3760, the last sentence of the first paragraph of proposed 35 U.S.C. § 24 had been changed to read:

"The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and the production of documents and things shall apply to contested cases in the Patent Office."

The result of the many suggestions from the Patent Bar and the public concerning H.R. 9133 and the reintroduction of this bill in revised form in the 82nd Congress as H.R. 3760 is contained in House Report No. 1923, May 12, 1952. This history reveals the substitution for the words "the issuance of subpoenas duces tecum" of the words "the attendance of witnesses and the production of documents and things," which is the language appearing in the 1952 Patent Act.

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The district court, in denying Frilette's motion to compel discovery, stated that the law as previously enunciated should no longer prevail because of the recent occurrence of two events: (1) the 1970 amendments to the Federal Rules of Civil Procedure which eliminated the good cause requirement as a prerequisite to Rule 34 document requests, and (2) the introduction by the Patent Office in June 1971 of the discovery provisions of Rule 287.

With respect to the 1970 amendments, the district court stated:

"Since the good cause requirement was apparently a factor in the federal courts' willingness to interpret § 24 broadly, this Court is unable to conclude that § 24 would have received a similar construction absent this safeguard. In such circumstances, it would not be unreasonable to continue to impose a good cause requirement under 35 U.S.C. § 24."

358 F.Supp. at 495-96, 178 USPQ at 388-389. The district court went on to conclude that Frilette had not made a showing of good cause.

With respect to the recent introduction by the Patent Office of the discovery provisions of Rule 287, the district court stated that the absence of any discovery mechanism in the Patent Office prior to the promulgation of Rule 287 had been a significant factor in the federal courts' willingness to give 35 U.S.C. § 24 a broad reading and to assume jurisdiction over discovery matters in interference proceedings. The district court felt that the introduction of the Patent Office discovery rules "appear[s] to reflect the Patent Office's efforts to construct a discovery process which embodies the good cause requirement cited" in such cases as *In re Natta*, supra, and that Rule 287 might, therefore, require a redefinition of the federal courts' role in granting discovery in interference proceedings under 35 U.S.C. § 24.

Based upon the above two considerations, the district court announced the following limitation on its role in interference discovery cases arising under 35 U.S.C. § 24:

"While a federal court cannot abrogate its responsibility to assume jurisdiction under 35 U.S.C. § 24, it must not blind itself to the ancillary, supportive role, it is designed to fulfill in interference matters. Until the Patent Office has had a reasonable opportunity to implement its discovery procedures and has demonstrated the parameters within which they will be administered, the courts are in no position to evaluate the potential efficacy of the procedures and the possibility that the courts will be able to assume a secondary role in discovery. In light of these general considerations, the Court must scrutinize Frilette's particular discov-

ery requests in light of the issues before the Patent Office."

358 F.Supp. at 496, 178 USPQ at 389.

Frilette's primary contention on appeal is that, in light of the elimination by Congress in 1970 of the good cause requirement as a prerequisite to the grant of discovery under F.R. Civ. P. 34, the district court erred in judicially imposing a good cause requirement upon a party seeking discovery in an interference proceeding.

Specifically, Frilette claims that the district court's resurrection of the good cause requirement, on the ground that 35 U.S.C. § 24 would have received a different construction by this court in *Natta* and other courts absent the good cause safeguard, has no basis in logic. First, Frilette notes that good cause is not, and never was, a requirement of any of the discovery rules except F.R. Civ. P. 34, and that courts have granted discovery in patent interferences under such other discovery rules without regard to good cause. See, e.g., *Babcock & Wilcox Co. v. Foster Wheeler Corp.*, 54 F.R.D.474, 172 USPQ 286 (D. N.J. 1971) (motion to compel discovery under F.R. Civ. P. 37). Secondly, Frilette contends that the reasons for the 1970 amendment of F.R. Civ. P. 34, eliminating the good cause requirement, apply with equal force whether the parties seeking discovery are parties to a Patent Office interference or litigants in a different type of civil proceeding.<sup>5</sup> Finally, Frilette contends that the application of a different standard to the scope of discovery under the Federal Rules when the interference is pending before the Patent Office would not only impair the Patent Office's quest for truth but also necessarily increase the number of suits in the district courts under 35 U.S.C. § 146 after decisions of the Board of Patent Interferences since, as the district court in the instant case noted, "on appeal to the district court from a decision by the Board of Patent Interferences, the movant may be entitled to broad discovery under the Federal Rules without any showing of good cause or other particular reason for the requested discovery." 358 F.Supp. at 498 n. 7, 178 USPQ 390. Thus, Frilette argues, losing parties in interference proceedings are more inclined to bring a civil action under 35 U.S.C.

<sup>5</sup> The Advisory Committee's Note concerning the 1970 changes in F.R. Civ. P. 34 stated:

"Good cause is eliminated because it has furnished an uncertain and erratic protection to the parties from whom production is sought and is now rendered unnecessary by virtue of the more specific provisions added to Rule 26(b) relating to materials assembled in preparation for trial and to experts retained or consulted by parties."

See Moore's Federal Practice, Vol. 4A, ¶ 34.01[8] 2d ed. (1972).

§ 146 if broader discovery is available in such civil action.

I agree with these contentions and accordingly would hold that the district court erred in judicially imposing a good cause requirement upon discovery in patent interferences under 35 U.S.C. § 24. In 1970, Congress saw fit to permit the removal of the good cause requirement from the Federal Rules of Civil Procedure to become effective, and I perceive no logical reason why courts should carve an exception to such legislative action with respect to patent interferences. The district court, in resolving Frilette's request for discovery in the instant case, should have considered the same factors that it would consider in resolving a discovery request in any other civil proceeding.

One further aspect of this case requires discussion. As stated above, the district court, in addition to requiring Frilette to show good cause, stated that the Patent Office's recent promulgation of Rule 287 rendered distinguishable the *Natta* case and other cases which provided for broad discovery in the federal courts under 35 U.S.C. § 24. Reasoning that the presence of Rule 287 might require a restructuring of the federal courts' role under 35 U.S.C. § 24 and enable federal courts to assume a more limited, secondary role in interference discovery matters, the district court proceeded to "scrutinize Frilette's particular discovery requests in light of the issues before the Patent Office." The district court then noted, in denying Frilette's motion, "that under Rule 287(a) and (c), Frilette's discovery directed to Kimberlin's case in chief is premature." 358 F.Supp. at 498, 178 USPQ at 390. The district court did not make clear, however, whether its denial of Frilette's motion was based solely upon Frilette's inability to show good cause or also upon the Patent Office's prior denial of Frilette's motion as premature under Rule 287(a) and (c). Because of this uncertainty, I would remand to the district court for reconsideration of Frilette's discovery motion and, if necessary, clarification of its reasons for denial of such motion, in light of my belief that the district court erred in requiring Frilette to show good cause.

Accordingly, I would not attempt to resolve definitively in this appeal the issue of what effect Patent Office Rule 287 has upon the availability of discovery under 35 U.S.C. § 24, particularly where the Board of Patent Interferences has denied a motion under Patent Office Rule 287 requesting the same discovery.<sup>6</sup> I have, however, substantial doubt as

<sup>6</sup> I recognize that in many cases it will be desirable for the parties to seek discovery first under Rule 287, but it is not necessary to make a definitive ruling on this point in this case. See *Frilette v. Kimberlin*, 358 F.Supp. 493-496, 178 USPQ at 387-389

to whether the presence of Rule 287 compels a narrowing of the federal court's broad role in interference discovery proceedings under 35 U.S.C. § 24. Several factors underlie this doubt. First, on its face, Rule 287 provides for only limited discovery in the Patent Office. Under Rule 287(a), discovery is available prior to the testimony period solely for the purpose of determining the matters upon which the opponent will rely, not those which might build an affirmative case for the discovering party.<sup>7</sup> Therefore, Rule 287 does not provide for discovery as broad in scope as the discovery which may be provided by a district court under § 24. Secondly, Congress, presumably well aware of the conflict between the availability of broad discovery under 35 U.S.C. § 24 and the traditional order of proof procedure of interference proceedings,<sup>8</sup> repeatedly refused to amend 35 U.S.C. § 24 to eliminate this conflict prior to the adoption of Rule 287 in June 1971.<sup>9</sup>

(D. Del. 1973). See also note 9, *infra*. Also, I believe that any discovery ruling by the Patent Office is a factor to be considered by the district court in ruling on a motion such as that presented to the district court in this case. Cf. *Lavson v. Trans World Airlines*, 471 F.2d 76 (3d Cir. 1972); *In re Natta*, 264 F.Supp. 734, 738, 153 USPQ 11, 14-15 (D. Del. 1967).

<sup>7</sup> While Patent Office Rule 287(c) provides that the Board of Patent Interferences may grant further discovery privileges at any time during the interference proceeding and to the full extent allowed under the Federal Rules, this power is discretionary and is not subject to interlocutory review. Moreover, Rule 287 applies only to the parties, so that no discovery of witnesses not under the control of the parties is available.

<sup>8</sup> The traditional procedure in the Patent Office is that the parties present evidence in the inverse order of their filing date. Allowing the senior party to present its affirmative case after the junior party presents its affirmative case is intended to preserve the senior party's presumption that he is the first inventor. The discovery mechanism of Rule 287 is apparently designed to preserve this traditional procedure of maintaining the order of presenting proof by the parties.

<sup>9</sup> Congress has on several occasions refused to enact bills which proposed a change in the language of 35 U.S.C. § 24 to read as follows:

"(a) The clerk of any United States Court for the district wherein testimony is to be taken in accordance with regulations established by the Commissioner for use in any contested case in the Patent Office shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and the production of documents and things shall apply to contested cases in the Patent Office insofar as consistent with such regulations."

Finally, the language of 35 U.S.C. § 24 is mandatory, and it is questionable whether the Patent Office's promulgation of a narrow discovery rule can restrict the force and effect of such language. I believe that the district court should take the above factors into account in reconsidering Frilette's motion.

As a final matter, I reject the contention of appellee Kimberlin that the district court order denying Frilette's discovery motion was conditional rather than final, and that it was, therefore, not an appealable final order under 28 U.S.C. § 1291(a). See *Babcock & Wilcox Co. v. Foster Wheeler Corp.*, 415 F.2d 777, 163 USPQ 140 (3d Cir. 1969). In my view, the district court order was intended to be a final disposition of Frilette's motion for discovery.

I would vacate the May 15, 1973, district court order and remand the case to the district court for proceedings consistent with the foregoing views.

#### B. Duffy Case

As stated in Judge Adams' opinion, I agree that the district court did not abuse its discretion in allowing Duffy to proceed with discovery relating to whether Barnes and Preziosi filed their patent application fraudulently.

Judge Adams concurs in the statutory analysis set forth in this opinion and in the application of that analysis to the Frilette case.

See S. 3892, 90th Cong. 2d Sess. § 24 (1968); S. 1246, 91st Cong. 1st Sess. § 24 (1969); S. 643, 92nd Cong., 1st Sess. § 24 (1971). These bills were introduced before the Patent Office adopted Rule 287. Other bills introduced before the adoption of Rule 287 proposed no change in the language of 35 U.S.C. § 24. See S. 1042, 90th Cong., 1st Sess. § 24 (1967); S. 2597, 90th Cong., 1st Sess. § 24 (1967); S. 2756, 91st Cong., 1st Sess. § 24 (1969); cf. also S. 2504 (Committee Print), 93rd Cong., 1st Sess., A Bill for the general reform and modernization of the Patent Laws, title 35 of the United States Code at Section 23(b)(1), p. 10, Section 135(c)(3), p. 45, and Section 145 at p. 51.

## APPENDIX D

In *The Babcock & Wilcox Company v. Combustion Engineering, Inc.*, 314 F. Supp. 937 (D.C. Conn., 1968); aff'd 430 F.2d 1117 (C.A. 2, 1968), discovery by a junior party to a Patent Office interference under 35 U.S.C. § 24 was not limited to the preparation of rebuttal material but could be used for the preparation of his direct case. The court said that Congressional intent to allow both parties to apply for discovery at any time during the proceeding must only meet the requirements of good cause, relevance, reasonable designation of documents and privilege. Subsequent to that case, good cause was eliminated as a requirement of Rule 26 of the Federal Rules of Civil Procedure.

In *Gladrow v. Weisz*, 354 F.2d 464 (C.A. 5, 1965), the Fifth Circuit said that Rule 34 of the Federal Rules of Civil Procedure permits the court to require production of documents under the control of a party during cross-examination without a subpoena.

In *Ochsner et al. v. Mills*, 382 F.2d 618 (C.A. 6, 1967), in holding the District Court's order denying a motion to compel discovery was appealable, the Sixth Circuit noted that 35 U.S.C. § 141 and 35 U.S.C. § 146 review does not provide actual review of the District Court's ruling. Appeal to the CCPA, which is an alternative appeal from the Patent Office Board of Interferences, is limited to the record before the court. An appeal to a Federal District Court under 35 U.S.C. § 146 carries a presumption of administrative correctness which is not the case with an appeal to the CCPA. The Sixth Circuit thus found the order final and appealable, thereby affirming that discovery for



use in Patent Office interference was expressly provided by 35 U.S.C. §24 in conjunction with the Federal Rules of Civil Procedure.

In *Natta et al. v. Zletz et al.*, 379 F.2d 615 (CA 7, 1967), the Seventh Circuit stated that the Patent Office had no power to order production, much less did it have any power to review the question of appellants' rights to the documentary production denied appellants by the District Court. The ruling by the District Court below that it would not entertain Rule 34 discovery until the Patent Office set a specific time for testimony was reversed by the Seventh Circuit which went on to state that it was error for the District Court to so condition the exercise of its authorized ancillary jurisdiction (under 35 U.S.C. §24), a jurisdiction designed cooperatively to complement the Patent Office's jurisdiction as an aid in the quest for truth.

In *Natta et al. v. Zletz et al.*, 405 F.2d 99 (CA 7, 1968); cert. den'd 395 U.S. 909 (1969); the Seventh Circuit, in reversing the District Court's order as "too restrictive," held it "not in accord with the broad type of discovery and duty of full disclosure contemplated by the Patent Laws, including 35 U.S.C. §24." The maximum amount of evidence should be available to the Patent Office for its sifting of the interference issues, said the Seventh Circuit. Parties should have access to documents which are relevant or which may lead to relevant matters within the purview of Rules 26(b) and 34 of the Federal Rules of Civil Procedure.

In *Natta et al. v. Zletz et al.*, 418 F.2d 633 (CA 7, 1969), the Seventh Circuit stated that the application of attorney-client privilege and work product applies to Rule 34 discovery for use in a Patent Office interference.

In *Natta et al. v. Hogan et al.*, 392 F.2d 688 (CA 10, 1968), the Tenth Circuit specifically held that Rule 34 proceedings are "within the sweep of the statute [35 U.S.C. §24]" and that it is *not* necessary to obtain a subpoena prior to a Rule 34 motion.

In addition to the Courts of Appeals which have spoken out above on the situation, a number of District Courts have similarly found 35 U.S.C. §24 to provide to parties in a Patent Office interference the same type of discovery available to federal court litigants. In *Hogan et al. v. Zletz et al.*, only at 151 USPQ 103 (N.D. Okla., 1966), the District Court held that Rule 34 of the Federal Rules of Civil Procedure applies to actions brought under 35 U.S.C. §24. The assignee of an interference party is a party under Rule 34 even though not named per se in the interference because it is a real party in interest and therefor one party may take discovery from the assignee of the other party. In *Hogan et al. v. Zletz v. Baxter et al. v. Natta et al.*, 43 F.R.D. 308 (N.D. Okla., 1967), the District Court granted in part a motion for discovery under FRCP 34. The decision dealt in considerable detail with the work-product rule and attorney-client privilege which were found to be applicable to discovery for use in a Patent Office interference.

In *Judd v. Engelhard et al.*, only at 159 USPQ 571 (E.D. Wis., 1968), the District Court permitted discovery pursuant to FRCP 34 where the Patent Office interference motion period had closed but the Patent Office had not rendered a decision on the motions. The particular decision was one of the early decisions among the District Courts which not only acknowledged an interference party's right to federal court discovery, but acknowledged his right to such discovery at an early stage of the interference.

In *Ziegler et al. v. Natta et al.*, only at 157 USPA 400 (S.D.N.Y., 1968), the District Court for the Southern District of New York ruled on a motion under 35 U.S.C. §24 as to whether the documents sought via discovery were privileged.

In *Brinker et al. v. Kray et al.*, only at 159 USPQ 348 (S.D.N.Y., 1968), the District Court for the Southern District of New York denied a motion to quash a subpoena, saying that the court would not pass on the weight, sufficiency or relevancy which the Patent Office should accord the documents sought by production. The court went on to say that a serious challenge to inventorship was made and the petitioner did not show prejudice as a result of allowing discovery.

In *Gorzengo et al. v. Maguire et al.*, 62 F.R.D. (D.C. S.D.N.Y., 1973), the District Court of the Southern District of New York, in permitting discovery, said that an interference party could not both rely on an application in the interference and then deny the opposing party access to the document.

In *Vogel et al. v. Jones et al.*, 346 F. Supp. 1005 (D.C. D.C., 1970), the District Court for the District of Columbia granted a motion for summary judgment by the defendant in an action brought under 35 U.S.C. §146 to review a decision of the Patent Office Board of Patent Interferences. In that case, the District Court refused to allow the plaintiff to pursue discovery in the 35 U.S.C. 146 review action where the Patent Office had refused to postpone the testimony period because the plaintiff had not shown that the discovery sought was necessary. The court acknowledged that the plaintiff had a right to file a 35 U.S.C. §24 pro-

ceeding initially during the time the interference was pending in the Patent Office and therefore the court would not permit the plaintiff to take discovery in an action under 35 U.S.C. §146 after the Board of Patent Interferences had rendered its decision. The court stated that it would not consider evidence on issues for which no testimony was offered.

In *Lomax et al. v. Kihara v. Von Der Ohe*, only at 175 U.S.P.Q. 538 (D.C. D.C., 1972), the District Court for the District of Columbia denied a motion to quash and authorized discovery under 35 U.S.C. §24 and Rule 26 of the Federal Rules of Civil Procedure *even though* the Patent Office had denied a motion by this same party under Patent Office Rule 37 C.F.R. 1.287 seeking discovery. The court stated that the arguments presented included the observation that the Patent Office is very strict and restricts discovery to admissible evidence rather than to relevant evidence as does the federal court. The court indicated that granting Rule 26 discovery would not "annihilate" Patent Office Rule 37 C.F.R. 1.287.



Supreme Court, U. S.

FILED

JUN 19 1976

MICHAEL S. BODAK, JR., CLERK

IN THE

**Supreme Court of the United States**

OCTOBER TERM, 1975

**No. 75-1743**

FRANK PETER DOYLE, JOHN HERBERT CHARLES NAYLER  
and GEORGE NEWBOLD ROLINSON,

*Petitioners,*

—v.—

JOHN C. SHEEHAN,

*Respondent.*

**SUPPLEMENTAL APPENDIX TO  
PETITION FOR A WRIT OF CERTIORARI TO THE  
UNITED STATES COURT OF APPEALS  
FOR THE FIRST CIRCUIT**

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**Memorandum and Order**

**UNITED STATES COURT OF APPEALS**

**FOR THE FIRST CIRCUIT**

**No. 75-1218**

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**JOHN C. SHEEHAN,**

*Plaintiff, Appellee,*

**—v.—**

**DOYLE et al.,**

*Defendants, Appellants.*

---

**Before COFFIN, Chief Judge,**

**McENTEE and CAMPBELL, Circuit Judges.**

**Entered: March 3, 1976**

Doyle petitions for rehearing and alternatively for certification pursuant to 28 U.S.C. § 1254(3). Just as Doyle's appeal was an attempt to reargue, contrary to normal principles of *stare decisis*, a decision of this court that was rendered less than a year previous, the present petition attempts contrary to our local rules to reargue the issues already argued on appeal. In hindsight, our decision was phrased more mildly than it should have been, given Doyle's tactics and arguments; we did not, as normally we would and as urged by appellee, flatly characterize Doyle's appeal as frivolous. Rather, we entertained Doyle's argu-

ments to make certain that our views on the discovery issue reflected the best judgment of which we were capable.

This apparently was not enough for Doyle. Indeed, it may have stimulated him to believe that we welcome endless appellate review even if we do not welcome endless discovery. Overlooking that this circuit consists of but three active judges, all of whom sat on his appeal, Doyle now demands an *en banc* hearing, and suggests that our relevant circuit rule tailored to the size of this court is improper. This peculiar approach is, by itself, unimportant, since apart from the rules all members of this court join in rejecting the request for an *en banc* hearing, and we know of no rule change that could transform three judges into more. We are left, however, with the unfortunate impression that counsel might not have been engaging in empty threats when he indicated during oral argument that if the issue went against his client, it would be presented again and again, implying, perhaps, that he might push the judicial process to, and even beyond, its limits in retaliation for anything less than victory. We still hope that we misread counsel in this regard, but the nature of the present petition does not encourage us.

Doyle gives as one ostensible reason for rehearing that he should not be taxed, like most losing parties, for the costs of his appeal. Doyle makes no mention of the fact that the appeal was taken in the face of very recent and clear circuit precedent. So obvious was this that the district court ruled against Doyle without opinion, and appellee took the position, with obvious justification, that because of our previously announced position, Doyle's appeal was frivolous. Doyle's professed surprise, therefore, at being taxed costs can only be described as amazing. Indeed,

Doyle's argument as to costs is so contrived that we wonder whether instead of being advanced in good faith it is designed merely to circumvent our local Rule 15.

The rest of the petition consists of a rehash of previous arguments, including reference to a second circuit decision with which we are entirely familiar, interlaced with the strident demand that we explain ourselves to appellants' satisfaction, and the warning that our views, like those of the third circuit and the editors of the Harvard Law Review, are completely unacceptable, and, indeed, do not represent existing law.

We well understand a losing party's disappointment, and as we indicated in our opinion, we appreciate the desirability of a resolution of the issue presented in the case as to which the circuits have split. We do not claim infallibility. We cannot, however, condone counsel's inability to grasp that there must be finality to a judicial proceeding.

Finally, we are not persuaded that any useful purpose would be served by the certification procedure requested if, indeed, it was appropriate for such a request to emanate from appellant. C. Wright, Law of Federal Courts, 479-80 (2d ed. 1970).

The petition for rehearing is denied, as is the request for hearing *en banc* and for certification to the Supreme Court.

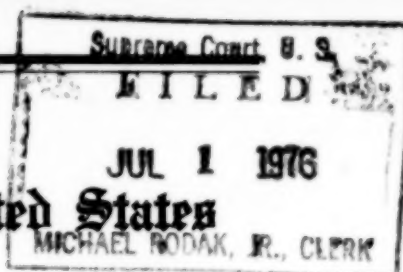
By the Court:

/s/ DANA H. GALLUP  
Clerk



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IN THE  
**Supreme Court of the United States**  
October Term, 1975



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**No. 75-1743**

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FRANK PETER DOYLE, JOHN HERBERT CHARLES NAYLER  
and GEORGE NEWBOLD ROLINSON,  
*Petitioners,*

*v.*

JOHN C. SHEEHAN,  
*Respondent.*

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**RESPONDENT'S BRIEF IN OPPOSITION TO  
PETITION FOR WRIT OF CERTIORARI TO  
THE UNITED STATES COURT OF APPEALS  
FOR THE FIRST CIRCUIT**

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IN THE

# Supreme Court of the United States

October Term, 1975

**No. 75-1743**

FRANK PETER DOYLE, JOHN HERBERT CHARLES NAYLER  
and GEORGE NEWBOLD ROLINSON,  
*Petitioners,*

*v.*

JOHN C. SHEEHAN,  
*Respondent.*

## RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

### Opinions Below

The opinions below appear at pages 1a through 5a of the Appendix to the Petition and at pages 1 through 3 of the Supplemental Appendix to the Petition.

### Jurisdiction

The statutory provisions are adequately set forth in the Petition.



### Statement of the Case

Petitioner's Statement of the Case has omitted several important facts and judicial decisions relevant to the Court's consideration of the Petition.

Following completion of the Doyle et al. discovery from Sheehan referred to in the paragraph bridging pages 6-7 of the Petition, Sheehan requested production of documents under authority of 35 U.S.C. §24 from Doyle, Rolinson and Nayler, the alleged coinventors. The District Court for the District of Massachusetts ordered Doyle et al. to produce the documents and an appeal was taken. On March 31, 1975 the First Circuit Court of Appeals reversed the District Court (*Sheehan v. Doyle*, 513 F.2d 895) in a case of first impression sustaining Doyle et al. on the ground that 35 U.S.C. §24 "does not confer jurisdiction upon the district court, acting on its own, to grant Rule 34 discovery directly, whether against a non-resident alien or a resident citizen" (513 F.2d at 898). We petitioned this Court on behalf of Sheehan but the Writ of Certiorari was denied. (— U.S. —, October 6, 1975, No. 74-1644).

The decision below is therefore the second instance in which the First Circuit Court reviewed 35 U.S.C. §24, and merely confirmed the construction and application of its prior precedent. The parties have thus come full circle in less than a year, with Doyle et al. now urging a review of the circuit court's construction of 35 U.S.C. §24, which review the Court has previously denied to Sheehan.

### Summary of the Argument

Respondent believes that the decision of the court below does not present an issue for review by this Court for the following reasons:

- (a) Pending legislation to revise the patent laws generally would eliminate this challenged provision of 35 U.S.C. §24 altogether, and if enacted prior to the Court's final decision, could render the Court's decision moot.
- (b) Arguments relating to the merits of the discovery issue were referred to by the court below and the ultimate effect of its decision is manifestly correct.
- (c) The present case does not involve an important question of law which would substantially affect the rights of the public.

### Reasons for Denying the Writ

**I—Pending legislation to revise the patent laws generally would eliminate this challenged provision of 35 U.S.C. §24 altogether and if enacted prior to the Court's final decision, could render the Court's decision moot.**

While we cannot deny the conflict in the decisions of the Courts of the First and Third Circuits with those of the courts of the remaining circuits which have construed and applied 35 U.S.C. §24, we do not believe that this matter warrants the Court's attention at this time.

Petitioners have twice quoted from that part of the opinion by the court below which stated that this conflict of

statutory construction could be resolved by this Court. However, the court below also recognized that the conflict could be resolved by another body, i.e., the Legislature, and the complete passage (of which Petitioners have quoted only a part) is as follows:

We regret the uncertainty which a circuit split creates. There are, however, possible remedies. The Supreme Court may think it desirable to terminate the divergent interpretations that now exist. Alternatively, other circuits may follow the third circuit in abandoning the earlier construction. And the Commissioner of Patents, exercising such powers as he now has, may find that he is able to contribute to clarification of the situation. *Finally, of course, Congress may by legislative enactment make clear its wishes in this unsettled area.* (Appendix to Petition, pages 3a-4a) [emphasis supplied]

The Congress, in fact, does presently have under consideration legislation which, if enacted, would significantly revise the specific statutory section in question. This legislation, entitled "*An Act For the general revision of the Patent Laws, title 35 of the United States Code, and for other purposes,*" has already been passed by the full Senate as S.2255. On March 1, 1976 this act was referred to the Committee on the Judiciary of the House of Representatives. An abridgment of this pending legislation reproducing the relevant sections is included as Appendix A to this brief.

In the Senate-passed version of S.2255, Sections 23 and 24 put control of patent interference discovery matters solely in the hands of the Board of Patent Interferences with the power to issue subpoenas. See Sections 5(c)(3)

and 136 of S.2255. Rules for obtaining discovery are to be established by the Commissioner of Patents and Trademarks. Nowhere in S.2255 is there a provision comparable in terms or effect to the provisions of the present 35 U.S.C. §24. Thus, the federal courts will not have primary jurisdiction to issue subpoenas in connection with discovery in patent interference proceedings. The courts will have authority to review the issuance of, and compliance with subpoenas issued by the Patent Office Board.

While no public hearings have been held, it is possible that should the Court grant the Petition the legislation could be enacted prior to the Court's final opinion on the proper construction of the present 35 U.S.C. §24. The question would thereby be rendered moot since further discovery proceedings would have to be undertaken in accordance with the provisions of the new statute.

In view of these recent developments and the significant changes in the pending legislation governing the conduct of discovery in patent interference proceedings we do not believe that the issue raised by Petitioners warrants the Court's attention at this time. We respectfully submit that it would be within the exercise of the sound discretion of the Court to deny the Petition in view of this pending federal legislation, which in the version already passed by the Senate would render moot the narrow issue of law under consideration.

**II—The effect of the ruling of the court below is manifestly correct and warrants a denial of certiorari.**

It is an established principle governing appellate review that a ruling or decision of a lower court itself correct in law, will not be disturbed on appeal merely because given for a wrong reason.

Regardless of the basis of the district court's original decision, the result—to deny discovery to Doyle et al.—was correct under the controlling precedent.

Petitioners have admitted in their brief that their sole basis for the discovery is to challenge the accuracy of the inventorship entity named in the patent which is in interference. Those tribunals having primary jurisdiction over the conduct of the interference proceedings have held that the issue of inventorship cannot be determined under the circumstances of this interference.\*

The opinion of the court below reproduced in Appendix A to the Petition noted that Sheehan had argued that the issue of inventorship was entirely irrelevant in the context of the interference (Petition, page 2a). The court below, while obviously never reaching the merits of the issues of scope and relevance, did have in the record before it a final decision by the Commissioner of Patents holding

\* See, for example, *Cooper v. Hubbell*, 53 F.2d 1072 (CCPA 1931); *Derby v. Whitworth*, 62 F.2d 368 (CCPA 1932); *Hess v. Dryfuss*, 104 F.2d 801 (CCPA 1939); *Smith v. Kliersath*, 120 F.2d 1015 (CCPA 1941); *Sherman v. Hope, Jr.*, 161 F.2d 263 (CCPA 1947); *Mortsell v. Laurila*, 301 F.2d 947 (CCPA 1962); *Huang v. Cheney*, 362 F.2d 816 (CCPA 1966); *Beeber et al. v. Krough et al.*, 403 F.2d 743 (CCPA 1968); and *Arey et al. v. Streed and Yan*, 176 USPQ 274 [no Fed. cite] (P.O. Bd. of Pat. Inter. 1971).

that the issue of third party inventorship of the Sheehan patent could not be raised by Doyle et al. in this particular interference. This decision on the Doyle et al. petition to the Commissioner of Patents dated April 14, 1975 is reproduced as Appendix B hereto.

We believe that inasmuch as the effect of this ruling by the Commissioner conclusively estops Doyle et al. on the merits from ever obtaining the discovery sought, the correctness of the result of the decision by the court below is established.

Since the order denying discovery was supported by a sound, although unstated, theory of law, this Court should not consider overturning the decision merely because the stated reasoning has been challenged. Under these circumstances, and in accordance with the prior decisions of this Court, the petition should be denied.

**III—The present case does not involve an important question of law which would substantially affect the public interest.**

Approximately one year ago we filed on behalf of Sheehan a petition for a writ of certiorari to the First Circuit Court of Appeals raising substantially the same question with regard to that court's construction of 35 U.S.C. §24. At that time there were pending two other petitions for writs of certiorari to the Third Circuit Court of Appeals in the cases of *Frilette et al. v. Kimberlin et al.*, 508 F.2d 205 (1974), and *Duffy v. Barnes et al.*, 508 F.2d 205 (1974), likewise challenging that court's construction of 35 U.S.C. §24. This Court denied all three petitions in



1975 (421 U.S. 979). Since the conflict between the decisions of the circuits was as apparent then as it is now, and yet each of the petitions was denied, we can only conclude that other matters had taken precedence over this narrow question relating to patent interference practice.

Putting the matter in perspective, it is apparent that the effect of denying discovery to Petitioners does not decide any of the interference issues on the merits, but involves only a matter of discovery procedures. Most significant is that the sole effect of the decision which Petitioners ask this Court to review is to deny to them the federal district court as an alternate forum of *first resort* for judicial subpoenas to be used in aid of discovery related to the patent interference proceeding. The ruling, while adverse to Petitioners, is not necessarily finally determinative of their right to the discovery sought. The existing Rules of Practice of the Patent and Trademark Office provide that such discovery may be granted upon application if supported by a proper showing. Rule 287(c) [37 C.F.R. Section 1.287(c)] reproduced in Appendix C to this Brief outlines the procedure and requirements. Petitioners have not brought a motion for the discovery sought under Patent Office Rule 287(c), and have therefore not exhausted their administrative remedies. We believe that it was the specific purpose of the First Circuit Court to impose upon interference parties the requirement that they first apply to, and obtain authorization from, the Patent Office Board of Interferences for any such additional discovery. For these reasons, the decision of the court below does not present an issue for review by this Court.

### Conclusion

**For the reasons stated the Petition should be denied.**

Respectfully submitted,

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# APPENDICES

## APPENDIX A

94th Congress, 2d Session S. 2255—

An Act for the general revision of the Patent Laws, title 35 of the United States Code, and for other purposes. (Sections 5(c)(3), 23, 24 and 136 only.)

94TH CONGRESS  
2D SESSION

**S. 2255**

## IN THE HOUSE OF REPRESENTATIVES

MARCH 1, 1976

Referred to the Committee on the Judiciary

**AN ACT**

For the general revision of the Patent Laws, title 35 of the United States Code, and for other purposes.

1 *Be it enacted by the Senate and House of Representatives of the*  
2 *United States of America in Congress assembled, That, in accordance*  
3 *with the authority granted by article 1, section 8, clause 8 of the*  
4 *United States Constitution, title 35 of the United States Code entitled*  
5 *"Patents", is hereby amended in its entirety to read as follows:*

**"TITLE 35—PATENTS**

<b>"PART</b>	<b>Sec.</b>
<b>"I. PATENT AND TRADEMARK OFFICE.....</b>	<b>1</b>
<b>"II. PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS.....</b>	<b>100</b>
<b>"III. PATENTS AND INFRINGEMENT OF PATENTS.....</b>	<b>261</b>
<b>"IV. PATENT COOPERATION TREATY.....</b>	<b>351</b>

**"PART I—PATENT AND TRADEMARK OFFICE**

<b>"CHAPTER</b>	<b>Sec.</b>
<b>"1. ESTABLISHMENT, OFFICERS, FUNCTIONS.....</b>	<b>1</b>
<b>"2. PROCEEDINGS IN THE OFFICE.....</b>	<b>21</b>
<b>"3. PRACTICE BEFORE THE OFFICE.....</b>	<b>81</b>
<b>"4. OFFICE FEES.....</b>	<b>41</b>

**"Chapter 1.—ESTABLISHMENT, OFFICERS, FUNCTIONS**

<b>"Sec.</b>
<b>"1. Establishment.</b>
<b>"2. Seal.</b>
<b>"3. Commissioner and other officers.</b>
<b>"4. Restrictions on officers and employees as to interest in patents.</b>
<b>"5. Board of Examiners-in-Chief.</b>
<b>"6. Library.</b>
<b>"7. Classification of patents.</b>
<b>"8. Certified copies of records.</b>
<b>"9. Publications.</b>
<b>"10. Research and studies.</b>
<b>"11. Annual report.</b>



1   **"§ 5. Board of Examiners-in-Chief**

2       **"(a) There shall be in the Office not to exceed sixty examiners-in-**  
3       **chief, who shall be appointed under the competitive service.**

4       **"(b) The examiners-in-chief shall constitute a Board of Examin-**  
5       **ers-in-Chief. The examiners-in-chief shall be persons of competent**  
6       **legal knowledge and scientific ability. The Chairman of the Board**  
7       **shall be appointed by the Commissioner.**

8       **"(c) The Board of Examiners-in-Chief shall:**

9           **"(1) review (as provided in chapter 12 of this title) final rejec-**  
10          **tions by primary examiners; and**

11          **"(2) render other decisions and orders, and take other agency**  
12          **action, as provided in this title; and**

13          **"(3) perform the functions specified as being performed by a**  
14          **Board of Patent Interferences in other Acts of Congress and**  
15          **when performing said function shall constitute a Board of Patent**  
16          **Interferences; and**

17          **"(4) render other decisions and orders as the Commissioner**  
18          **may by regulation or order prescribe.**

19       **"(d) Except as otherwise provided in or pursuant to this title, the**  
20       **Board of Examiners-in-Chief shall exercise all judicial functions of**  
21       **the Office, including all agency review of appeals, under this title.**  
22       **Except as provided otherwise in this title, the decision of the Board**  
23       **of Examiners-in-Chief shall constitute final agency action (as that**  
24       **term is defined in 5 U.S.C. 551) in all matters considered by it, and**  
25       **shall be the final decision of the Office for the purposes of chap-**  
26       **ter 13 of this title.**

27       **"(e) Each appeal or other action shall be heard or considered by a**  
28       **panel of one or more members of the Board of Examiners-in-Chief,**  
29       **as the Commissioner by general regulation shall prescribe. Said panel**  
30       **shall be designated for each case by the Chairman of the Board. The**  
31       **Board of Examiners-in-Chief shall have sole power to grant rehear-**  
32       **ings.**

**A2.**

**9**

**23**

**"Chapter 2.—PROCEEDINGS IN THE OFFICE**

**"Sec.**

- "21. Day for taking action falling on Saturday, Sunday, or holiday.**
- "22. Form of papers filed.**
- "23. Issue of subpoenas and other orders by Board of Examiners-in-Chief; review and enforcement.**
- "24. Issue of subpoenas and other orders in investigations; review and enforcement.**
- "25. Oath and declaration in lieu of oath.**
- "26. Effect of defective or missing execution.**
- "27. Postal interruptions.**

1 **"§ 23. Issue of subpoenas and other orders by Board of Examiners-**  
2 **in-Chief; review and enforcement**

3 "(a) Any party to a proceeding before the Board of Examiners-in-  
4 Chief may apply at any time to the Board or any member thereof for  
5 subpoenas or discovery orders to provide testimony, evidence, deposi-  
6 tions, or other information, and the Board or any member thereof shall  
7 issue the same ex parte to (1) the Solicitor; (2) parties to proceedings  
8 had pursuant to section 5(c) (3) or 136 of this title; and (3) upon a  
9 showing of good cause, to parties to proceedings had pursuant to sec-  
10 tion 135 of this title. Any member also may issue such subpoenas or  
11 orders on his own motion in any proceeding. Subpoenas and orders may  
12 issue against the applicant or any person within the jurisdiction of the  
13 United States, whether or not he is a party in the proceeding.

14 "(b) (1) The Commissioner shall establish rules for obtaining such  
15 discovery, testimony, evidence, affidavits, or other information. Subject  
16 to subsection (a) of this section, such rules shall provide any party to  
17 the proceedings all discovery permitted, and the sanctions, other than  
18 contempt, for noncompliance therewith, prescribed in the Federal  
19 courts pursuant to the Federal Rules of Civil Procedure, as now in  
20 force or amended hereafter, with such different time limits as the  
21 Commissioner may by regulation prescribe. Such rules shall provide,  
22 further, for protective orders and for the payment of witness fees  
23 and expenses as prescribed in the Federal Rules of Civil Procedure  
24 for proceedings in the district courts.

25 "(2) (A) The Board of Examiners-in-Chief or any member thereof  
26 shall have the power, in accordance with such regulations not incon-  
27 sistent with the Federal Rules of Civil Procedure as the Commis-  
28 sioner shall prescribe, to sustain, quash, or modify subpoenas or orders  
29 issued pursuant to subsection (a) of this section.

30 "(B) In the case of a person (other than an employee or agent of  
31 a party to the proceeding) not party to the proceedings before the  
32 Board of Examiners-in-Chief, such person also may move to quash  
33 or modify subpoenas or orders issued pursuant to subsection (a) of  
34 this section in the United States District Court for the judicial district  
35 in which such person resides.

36 "(c) (1) Agency action pursuant to subsections (a) and (b) of this  
37 section shall not be deemed final decisions or orders for the purposes of  
38 chapter 13 of this title. Judicial review of orders pursuant to subsec-  
39 tions (a) and (b) of this section may be had upon review of the final  
40 decision or order in the entire proceeding, pursuant to chapter 13 of



1 this title, or as may otherwise be required by sections 701-706 of title  
2 5, United States Code.

3 “(2) (A) Any party aggrieved by refusal or failure to comply  
4 with a subpoena or order issued, and not quashed, pursuant to sub-  
5 section (a) or (b) of this section, may apply for such civil enforce-  
6 ment by moving for an order to show cause why the person refusing  
7 or failing to comply with such subpoena or order should not be com-  
8 manded by the court to comply therewith. Such application shall be  
9 to the United States District Court for the District of Columbia. The  
10 process of such district court for such purpose shall run through the  
11 United States and otherwise as provided by the Federal Rules of  
12 Civil Procedure or any Federal statute.

13 “(B) In the case of a person (other than an employee or agent of a  
14 party to the proceeding) not a party to the proceeding before the  
15 Board of Examiners-in-Chief, the United States District Court for  
16 the District of Columbia may, if it finds that the interests of justice,  
17 judicial economy, and fairness to such person permit, transfer such  
18 application to the United States district court for the judicial district  
19 in which such person resides or may be found.

20 “(3) Disobedience of any court order entered pursuant to this sub-  
21 section shall be punishable as a contempt.

22 **“§ 24. Issue of subpoenas and other orders in investigations; review**  
23 **and enforcement**

24 “(a) To carry out the provisions of this title with respect to fraud  
25 and inequitable conduct, the Board of Examiners-in-Chief or any  
26 member thereof shall, upon the application of the Solicitor, and upon  
27 a showing of good cause, issue a subpoena or order to any applicant,  
28 patentee, or person within the jurisdiction of the United States—

29 “(1) requiring him to appear before a designated representative  
30 of the Office in a nonadjunctive proceeding to testify, or to  
31 produce documentary evidence or other information or material;  
32 or

33 “(2) requiring him to file reports or answers in writing to  
34 specific questions—

35 relating to any investigation or inquiry by the Solicitor, involving  
36 conduct which may be a violation of sections 31, 32, 33, 115, 131, 135  
37 or chapter 19 of this title, or likely to lead to the production of infor-  
38 mation relating thereto, whether or not the subject matter of the  
39 investigation or inquiry may also be involved in any proceeding

1 before a primary examiner or the Board of Examiners-in-Chief, or  
2 in any other proceeding before a court or other tribunal. A person  
3 so required to appear shall be entitled to the payment of witness fees  
4 and expenses as prescribed for proceedings in the district courts. A  
5 subpoena or order requiring such a person to appear at a proceeding  
6 held pursuant to paragraph (1) of this subsection may issue against  
7 any such person within the jurisdiction of the United States.

8 “(b) Agency review of subpoenas or orders issued pursuant to this  
9 section shall be in accordance with such rules as the Commissioner may  
10 prescribe.

11 “(c) In the case of disobedience to or failure to comply with such  
12 subpoenas or orders, the Solicitor may, in his discretion, seek enforce-  
13 ment thereof by the procedure specified in section 23(c) of this chapter,  
14 and the procedures specified therein shall be applicable to subpoenas  
15 and orders entered pursuant to this section.

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## **"Chapter 12—EXAMINATION OF APPLICATION**

"Sec.

"131. Examination of application.

"132. Examination proceedings.

"133. Time for prosecuting application.

"134. Appeal to the Board of Examiners-in-Chief.

"135. Opposition proceeding on the basis of information cited or furnished by others.

"135A. Reexamination.

"136. Procedures in priority of invention proceeding.

"137. Burden of persuasion.

"138. Effect of proceedings before the Office.

"139. Settlement agreements.



1   **"§ 136. Procedures in priority of invention proceeding**

2    **"(a) (1) Whenever there are two or more pending otherwise allow-**  
3    **able applications naming different inventors and claiming the same**  
4    **or substantially the same subject matter, and a priority of invention**  
5    **proceeding is instituted in accordance with subsection (b) of this sec-**  
6    **tion the Office shall designate as the 'senior party'—**

7       **"(A) the inventor named in the application having the earlier**  
8       **or earliest actual filing date in the United States, with respect**  
9       **to such subject matter, or**

10      **"(B) if two or more pending applications have the same actual**  
11      **filing date in the United States, the inventor named in one such**  
12      **application, in accordance with such regulations as the Commis-**  
13      **sioner shall prescribe.**

14    **"(2) The Office shall designate each inventor other than the senior**  
15    **party as a 'junior party.'**

16    **"(b) The priority of invention between or among the senior party**  
17    **and each junior party shall be decided by the Board of Examiners-**  
18    **in-Chief in a priority of invention proceeding, in accordance with**  
19    **such regulations as the Commissioner shall establish, if—**

20       **"(1) the application of such junior party is otherwise allow-**  
21       **able;**

22       **"(2) such junior party makes a prima facie showing of prior**  
23       **invention; and**

24       **"(3) such junior party offers to present evidence in support of**  
25       **such showing, within such time as the Commissioner shall pre-**  
26       **scribe by regulations.**

27    **"(c) (1) Subject to paragraph (2) of this subsection, and para-**  
28    **graphs (2) and (3) of subsection (b), whenever an otherwise allow-**  
29    **able claim of an application is for the same or substantially the same**  
30    **subject matter as a claim of an issued patent, the Office shall initiate a**  
31    **proceeding to determine priority of invention.**

32    **"(2) No claim for the same or substantially the same subject matter**  
33    **as a claim of an issued patent shall be allowed unless such claim is**  
34    **made within one year after the date on which such issued patent was**  
35    **granted. Nothing contained in this paragraph shall, however, preclude**  
36    **any person from asserting the unpatentability to the patentee of the**  
37    **subject matter of such a claim.**

38    **"(d) Failure of a junior party applicant to proceed under subsec-**  
39    **tion (b) or (c) of this section shall preclude such applicant from**  
40    **asserting priority of invention with respect to the subject matter**

1 claimed in the application, for the purpose of obtaining a patent.  
2 Failure of a junior party patentee to proceed under subsection (c) of  
3 this section shall operate to cancel such claim from the patent, and  
4 notice thereof shall be endorsed on copies of the specification of the  
5 patent thereafter distributed by the Office.

6 “(e) If any claim of an application involved in a priority of inven-  
7 tion proceeding is allowable with respect to subject matter not within  
8 the scope of the priority of invention proceeding, the Commissioner  
9 may, pursuant to section 155 of this title, issue a patent on such  
10 otherwise allowable claim or claims.

11 “(f) In any proceeding under this section, the Board of Examiners-  
12 in-Chief, or any party, may raise the question of the patentability of  
13 any claim which is involved in the proceeding or of any claim of the  
14 patent or application of one party over the subject matter claimed or  
15 disclosed in the patent or application of the other party, and such  
16 question shall be considered in the proceeding.

17 “(g) Upon a final decision in a priority of invention proceeding  
18 from which no appeal or other review has been or can be taken or had,  
19 the prevailing party shall be deemed entitled to priority of invention  
20 with respect to the subject matter of the claim or claims involved in the  
21 proceeding and with respect to the parties to the proceeding. The  
22 corresponding claims of the application or patent of each other party  
23 shall be rejected or canceled. Thereafter, pursuant to such regulations  
24 as the Commissioner may prescribe, the primary examiner or exam-  
25 iners shall continue the examination of the application or applications,  
26 pursuant to section 132 of this title.

27 “(h) Unless the prevailing party has elected interim issuance of a  
28 patent pursuant to subsection (e) of this section, the term of his patent,  
29 pursuant to section 154(b) of this title, shall be extended by a period  
30 equal to the time elapsed between the date he was made a party to the  
31 proceeding under this section and the date a final decision in his favor  
32 became effective. If he elected such interim issuance, the normal term  
33 pursuant to section 154(b) shall apply.

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**APPENDIX B**

**Decision by the Commissioner of Patents, dated April  
14, 1975 in Interference No. 97,577, On Petition**

**U.S. DEPARTMENT OF COMMERCE**

**PATENT OFFICE**

(Emblem)

Address Only: COMMISSIONER OF PATENTS  
WASHINGTON, D.C. 20231

Interference No. 97,577 :

SHEEHAN : On Petition

v. :

DOYLE *et al.* :

April 14, 1975

This is a petition by Doyle et al. from a decision on petition, November 18, 1974 in which the Commissioner acknowledged the right of Doyle et al. to call any witnesses of whom Sheehan had notice under Rule 287(a) or the equivalent thereof but limited to the question as to the sufficiency or inoperativeness of the disclosure of the parent Sheehan application S.N. 643,260, filed March 1, 1957. The Commissioner went on to state:

No basis or precedent is found for permitting, on the present record, testimony as to any other contention with respect to Sheehan's being accorded benefit of that application.

Doyle et al. assert that while they appreciate the favorable aspects of the Commissioner's decision, it is believed



important and equitable that they be permitted to present all testimony which would bear on Sheehan's right to be accorded the benefit of his abandoned parent application of March 1, 1957. The petition is opposed by Sheehan.

Doyle et al. allege that as a result of discovery proceedings including the deposition of Sheehan, they believe that they should be permitted to present factual testimony directly dealing with Sheehan's lack of "right" to the filing date of Sheehan's parent application. It is noted that Doyle et al. have not established in the petition that as a result of the discovery proceedings, the "factual testimony" to be presented even concerns matter ancillary to priority. As properly pointed out by Sheehan, Doyle et al. have demonstrated no new or additional bases for the relief sought. Accordingly, the Doyle et al. petition is *denied*.

Nor should this denial be interpreted as an invitation to Doyle et al. to make an additional showing relative to matters ancillary to priority. This interference, declared in February 1971 has been sufficiently protracted by a proliferation of papers filed by both parties herein and the time has come for the interference to move forward.

On February 3, 1975 Doyle et al. filed a supplement to the petition treated above. In this supplement, Doyle et al. desires to supplement same with copies of certain pages of a deposition of Sheehan and with certain laboratory notebooks of one Dr. Kenneth Henery-Logan. According to Doyle et al. these documents establish a prima facie inconsistency in the record as to the inventorship of the involved Sheehan patent; therefore Doyle et al. conclude that when testimony is taken to establish that the involved Sheehan patent does not have the correct inventorship entity, then

a prima facie case will have been raised that the patent is not entitled to the benefit of the parent Sheehan application. Additionally, Doyle et al. contend that a prima facie case would exist that said parent application does not contain the correct inventorship entity and this additionally would preclude reliance by Sheehan on the March 1, 1957 date for priority purposes in the instant interference. Sheehan has replied to the supplement to the petition and subsequent thereto pertinent papers were filed by both Sheehan and Doyle et al.

It is noted, under the circumstances of this case, there appears to be no issue of originality between the parties. Therefore, the issue of whether the involved Sheehan patent has the correct inventorship entity is an issue directed to third party inventorship which is not ancillary to priority and therefore may not be raised in an interference proceeding. *Mortsell v. Laurila*, 133 USPQ 380 (CCPA 1962); *Huang v. Cheney*, 150 USPQ 295 (CCPA 1966); *Beeber v. Grogh*, 159 USPQ 594 (CCPA 1968).

Accordingly, the Doyle et al. petition, supplemented by the paper filed February 3, 1975 is *denied*.

C. MARSHALL DANN

Commissioner of Patents and Trademarks

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(for DOYLE et al.)

# code of federal regulations

**37**

**Patents, Trademarks,  
and Copyrights**

Revised as of July 1, 1973



## Chapter I—Patent Office

37 C.F.R. 1.287

## § 1.287 Discovery.

(a) (1) Each party who expects to take testimony must serve on each opposing party who requests service the following:

(i) A copy of each document in his possession, custody, or control and upon which he intends to rely,

(ii) A list of and a proffer of reasonable access to things in his possession, custody, or control and upon which he intends to rely, and

(iii) A list giving the names and addresses of all persons whom he intends to call as witnesses and indicating the relationship of each person to the invention in issue.

(2) Dates for compliance with subparagraph (1) of this paragraph will be set in accordance with the following:

(i) The date by which all parties may request service shall be not less than 10 days from the date of the order setting testimony times;

(ii) The date for service by all junior parties shall be not less than 30 days from the date of the order setting such times;

(iii) The date for service by the senior party shall be not less than 10 days from the date set for the close of testimony in chief of all junior parties.

(3) Where more than two parties are involved and one of the junior parties is not entitled to take testimony as to a more senior party, the requirements of subparagraphs (1) and (2) of this paragraph shall not be applicable as between such parties.

(b) The provisions of paragraph (a) of this section are without prejudice to the right of a party, where appropriate, to obtain production of documents or things during cross-examination of an opponent's witness or during his own period for rebuttal testimony.

(c) Upon motion (§ 1.243) brought by a party during the period for preparation for testimony, or thereafter as authorized under § 1.245, and upon a showing that the interest of justice so requires, the Board of Patent Interferences may order additional discovery as to matters under the control of a party within the scope of the discovery rules of the Federal Rules of Civil Procedure, specifying the terms

and conditions of such additional discovery. An order by the Board granting or denying a motion under this paragraph shall not be subject to review prior to a decision awarding priority.

(d) (1) A party will not be permitted to rely on any document or thing in his possession, custody, or control, or on any witness, not listed and served by that party as required by paragraph (a) of this section, except upon a promptly filed motion accompanied by the proposed additional documents or lists together with a showing of sufficient cause as to why they were not served by the date set pursuant to paragraph (a) of this section.

(2) Any failure to comply with an order under the provisions of paragraph (c) of this section may be considered by the Board of Patent Interferences as basis for applying appropriate restrictions against the party failing to comply, for holding certain facts to have been established, and in an appropriate case for awarding priority against him, or for taking such other action as may be deemed appropriate.

(e) The parties may by agreement among themselves modify any of the foregoing requirements consistent with the schedule of times for taking testimony and filing the record. In the absence of such agreement, discovery will not be permitted prior to the period set for the preparation for testimony.

[36 F.R. 8733, May 12, 1971]



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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1975

No. 75-1743

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FRANK PETER DOYLE, JOHN HERBERT CHARLES NAYLER  
and GEORGE NEWBOLD ROLINSON,

*Petitioners,*

—v.—

JOHN C. SHEEHAN,

*Respondent.*

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**PETITIONERS' RESPONSE TO RESPONDENT'S  
BRIEF IN OPPOSITION TO PETITION FOR  
WRIT OF CERTIORARI TO THE UNITED  
STATES COURT OF APPEALS FOR THE  
FIRST CIRCUIT**

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*Frank Peter Doyle, John*

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IN THE  
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**PETITIONERS' RESPONSE TO RESPONDENT'S  
BRIEF IN OPPOSITION TO PETITION FOR  
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STATES COURT OF APPEALS FOR THE  
FIRST CIRCUIT**

Doyle et al. believe that Sheehan is attempting to mislead this court and obscure and obfuscate the issues presented by Doyle et al. in their Petition for Writ of Certiorari.

The fundamental and overriding issue presented by Doyle et al.'s Petition is a clear and unequivocal conflict within the Circuits. Sheehan admits there is a conflict (Sheehan Opposition, page 3). This conflict is underscored by the First Circuit's misinterpretation of 35 U.S.C. 24 and its violation of the plain meaning rule of statutory interpretation, which rule has been well recognized by this court.

Moreover, the discovery sought by Doyle et al. is directed to an issue which is recognized to be a matter appropriately raised in an interference proceeding. (See *Desch v. Dickinson* only at 99 USPQ 218 (P.O. Bd. Interf. 1950) and *Bloom et al. v. Furczyk et al.* only at 144 USPQ 678 (P.O. Bd. Interf. 1955).)

Lastly, Sheehan has raised as a false issue the matter of pending legislation. Senate Bill 2255 would not be retroactive. Passage of the bill during this session of Congress, before adjournment is doubtful, at best. Passage without any changes is still more doubtful.

Section 23(a) and (b)(1) of that bill would expressly grant to a party requesting it the very discovery which Doyle et al. have requested in the present case. However, the entire matter of pending legislation is believed to be so highly speculative as not to present a relevant consideration with respect to the Petition before this court.

Doyle et al. therefore respectfully request that this court grant their Petition for Writ of Certiorari.

Respectfully submitted,

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